

## **REMARKS**

In response to the Office Action mailed March 31, 2008, the Examiner's claim rejections have been considered. Applicant respectfully traverses all rejections regarding all pending claims and earnestly solicits allowance of these claims.

### **1. Claim Rejections – 35 U.S.C. § 102(e) - claims 21-25, 28-29, 41-44, and 46-47**

The Examiner has rejected claims 21-25, 28-29, 41-44, and 46-47 as being anticipated by Shamitoff. Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Independent claims 21 and 41 include the following features:

(1) wherein the main member exterior surface is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the main member is adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet;

(1) each pet toy secondary member having an exterior surface that is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the secondary members are adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.

The shortcomings of the Examiner's cited references (including the Shamitoff snapable stuffed doll), which are refuted in detail below, stem from a common problem. That problem is that the Examiner's cited references are not pet toys. Since the Examiner continues to cite references that are not pet toys, these references continue to have the same types of shortcomings, which relate directly to the fact that the toys are not designed or configured to be used by pets. Toys used by people have different considerations and functionality than toys that are designed by and configured for use by pets. Interestingly, it is clear that the Examiner has been searching for pet toys because the Examiner keeps returning with search results for people

toys that “look like” pets. Nevertheless, the above described shortcoming persist since the Examiner’s cited references are not pet toys.

First, the Examiner asserted that Shamitoff discloses “[t]he toy further includes secondary members with exterior surfaces that could be non-destructively gripped by a house pet using its mouth and paws.” (Office Action, p. 3, ll. 1-3). However, in stark contrast, the exterior of Shamitoff’s snapable stuffed doll is described as follows: “it is understood that the toy 100 may be covered in cloth, fabric, vinyl or other material that is conventionally used for stuffed toys.” (Shamitoff, col. 4, ll. 52-55) (emphasis added). Household pets readily and expeditiously puncture the fabric of stuffed animals, tear the fabric, and pull out the stuffing. Additionally, pets often pop the plastic eyeballs out of dolls. Conventional plastic eyeballs as well as synthetic stuffing material, if swallowed, can cause an animal to choke and / or have a gastro-intestinal track obstruction. In short, Shamitoff’s “material that is conventionally used for stuffed toys” cannot be construed to disclose the claimed “secondary members” that are “non-destructively detachable by a house pet.”

Second, the Applicant has amended the claims to clarify that (1) the main member is adapted to teeth of a dog and to withstand biting, chewing, and rending, and (2) the secondary members are adapted to teeth of a dog and to withstand biting, chewing, and rending. The Shamitoff snapable stuffed doll toy clearly does not disclose a main member or secondary members that are adapted to the teeth of a dog. Indeed, the Shamitoff snapable stuffed doll toy is plainly described as a “hand-held toy.” See Abstract. Thus, as described above, the Shamitoff device is designed for and configured to be used by people, not dogs or other household pets. Furthermore, Shamitoff snapable stuffed doll toy clearly does not disclose a main member or secondary members that are adapted to withstand biting, chewing, and rending. In contrast, the Shamitoff device is designed for and configured to be used by people, not dogs or other household pets. Moreover, as described above, Shamitoff’s “material that is conventionally used for stuffed toys” cannot be construed to disclose the claimed “adapted to withstand biting, chewing, and rending.” (Shamitoff, col. 4, ll. 52-55) (emphasis added).

Third, the Examiner asserted that Shamitoff discloses “[t]he main and secondary members are shaped and sized to prevent swallowing by a house pet.” (Office Action, p. 3, ll. 6-

8). However, in stark contrast, Shamitoff's snapable stuffed doll, as shown in FIG. 5, represents a toy with "a plurality of detachable appendages, including head 140, arms 142, 144 and legs 146, 148, each attached to a torso 150." (Shamitoff, at col. 4, ll. 63-65). Shamitoff's snapable stuffed doll is further described as having "portions of the head, including for example, eyes, ears, earrings, nose, mouth, moustache, beard and hair, [that] may be detachable to create a wide variety of characters." (Shamitoff, at col. 5, ll. 5-8). It is incongruous to state that eyes, ears, earrings, nose, mouth, moustache, beard and hair are "shaped and sized to prevent swallowing by a house pet." It is common knowledge that items such as eyes and earrings are extremely small by their very nature and therefore, easy to swallow by a common pet dog, such as a Labrador Retriever.

In sum, Applicant respectfully submits claims 21-25, 28-29, 41-44, and 46-47 are patentable over Shamitoff because Shamitoff does not disclose each and every limitation of the claims. Accordingly, Applicant further submits that the § 102(e) rejection of claims 21-25, 28-29, 41-44, and 46-47 has been overcome.

## 2. **Claim Rejection – 35 U.S.C. § 103(a) – claim 26**

The Examiner has rejected claims 26 under 35 U.S.C. § 103(a) as being unpatentable over Shamitoff and Russell. Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Shamitoff fails to teach or suggest each and every element of claim 26 for the reasons stated above in Section 1 of this response with respect to independent claim 21. While the Russell reference may disclose the additional limitation of claim 26, the Russell reference clearly does not supply the deficiencies of claim 21 set forth above in Section 1. Namely, neither the Shamitoff reference nor the Russell reference, teach or suggest:

(1) wherein the main member exterior surface is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the main member is adapted to teeth of a dog and to withstand biting, chewing, and

rending, and (3) wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet; ...

(1) each pet toy secondary member having an exterior surface that is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the secondary members are adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.

Accordingly, Applicant respectfully submits that claim 26 is not unpatentable over the Shamitoff reference and Russell reference, which fail to teach or suggest all of the claimed limitations, either alone or in combination. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 26 has been overcome.

### 3. **Claim Rejection – 35 U.S.C. § 103(a) – claim 27**

The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Russell and Alonso (USPN 3,375,604). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Shamitoff fails to teach or suggest each and every element of claim 27 for the reasons stated above in Section 1 of this response with respect to independent claim 21. While the Alonso reference may disclose the additional limitation of claim 27, the Alonso reference clearly does not supply the deficiencies of claim 21 set forth above in Section 1. Namely, neither the Shamitoff reference and nor the Alonso reference, teach or suggest:

(1) wherein the main member exterior surface is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the main member is adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet; ...

(1) each pet toy secondary member having an exterior surface that is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the secondary members are adapted to teeth of a dog and to withstand biting,

chewing, and rending, and (3) wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.

Accordingly, Applicant respectfully submits that claim 27 is not unpatentable over the Shamitoff reference and Alonso reference, which fail to teach or suggest all of the claimed limitations, either alone or in combination. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 27 has been overcome.

#### **4. Claim Rejection – 35 U.S.C. § 103(a) – claim 30**

The Examiner has rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Shamitoff and Essebaggers (USPN 5,108,100). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Shamitoff fails to teach or suggest each and every element of claim 30 for the reasons stated above in Section 1 of this response with respect to independent claim 21. While the Essebaggers reference may disclose the additional limitation of claim 30, the Essebaggers reference clearly does not supply the deficiencies of claim 21 set forth above in Section 1. Namely, neither the Shamitoff reference and nor the Essebaggers reference, teach or suggest:

(1) wherein the main member exterior surface is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the main member is adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet; ...

(1) each pet toy secondary member having an exterior surface that is non-destructively grippable by a house pet using its mouth and paws ... (2) wherein the secondary members are adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.

Accordingly, Applicant respectfully submits that claim 30 is not unpatentable over the Shamitoff reference and Essebaggers reference, which fail to teach or suggest all of the claimed

limitations, either alone or in combination. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 30 has been overcome.

#### **5. Claim Rejections – 35 U.S.C. § 103(a) – claims 45, 58, and 62**

The Examiner has rejected claims 45, 58, and 62 under 35 U.S.C. § 103(a) as being unpatentable. Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Shamitoff fails to teach or suggest each and every element of claims 45, 58, and 62 for the reasons stated above in Section 1 of this response with respect to independent claim 21. While the Shamitoff reference may disclose the additional limitation of claims 45, 58, and 62, the Shamitoff reference clearly does not supply the deficiencies of claim 21 set forth above in Section 1. Accordingly, Applicant respectfully submits that claims 45, 58, and 62 is not unpatentable over the Shamitoff reference, which fails to teach or suggest all of the claimed limitations, either alone or in combination. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 45, 58, and 62 has been overcome.

#### **6. Claim Rejections – 35 U.S.C. § 103(a) – claims 55-57 and 59-61**

The Examiner has rejected claims 55-57 and 59-61 under 35 U.S.C. § 103(a) as being unpatentable over Shamitoff. Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner asserts that it would have been a matter of design choice to make the device sized so as to prevent swallowing by a large dog. The Applicant plainly disagrees. As

has been described throughout, the size, shape, and configuration of the claimed components are not a merely matter of design choice because the Shamitoff reference utilizes a selection of components that are fundamental incompatible with the use by a dog or other household pet. Furthermore, the Shamitoff reference does not even recognize this fundamental threshold issue because the Shamitoff reference is not a pet toy, as required by the claimed invention.

Additionally, if the snapable, hand-held, stuffed doll toy of the Shamitoff reference was attempted to be modified in order to anticipate or render obvious the claimed invention of a pet toy, this would result in changing the principle of operation of the reference. The principle of operation would be completely changed by modifying the Shamitoff reference into a pet toy:

(1) wherein the main member exterior surface is non-destructively gripable by a house pet using its mouth and paws ... (2) wherein the main member is adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet; ...

(1) each pet toy secondary member having an exterior surface that is non-destructively gripable by a house pet using its mouth and paws ... (2) wherein the secondary members are adapted to teeth of a dog and to withstand biting, chewing, and rending, and (3) wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.

The Manual of Patent Examining Procedure, § 2143.01, states that "The Proposed Modification Cannot Change The Principle Of Operation Of A Reference." Thus, in accordance with M.P.E.P. § 2143.01, the teachings and suggestions of the Shamitoff reference CANNOT be modified using another prior art reference to disclose the claimed invention.

Shamitoff fails to teach or suggest each and every element of claims 55-57 and 59-61 for the reasons stated above in Section 1 of this response with respect to independent claim 21. While the Shamitoff reference may disclose the additional limitation of claims 55-57 and 59-61, the Shamitoff reference clearly does not supply the deficiencies of claim 21 set forth above in Section 1. Accordingly, Applicant respectfully submits that claims 55-57 and 59-61 is not unpatentable over the Shamitoff reference, which fails to teach or suggest all of the claimed limitations, either alone or in combination. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 55-57 and 59-61 has been overcome.

**CONCLUSION**

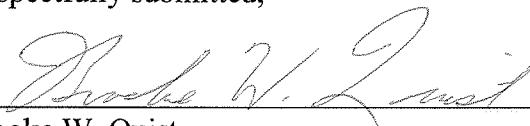
Applicant has made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 21-30, 41-47, and 55-62 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

Date: September 30, 2008

  
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